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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/718,445	11/20/2000	Warren Adams	249768040US	2880
25096	7590	10/13/2005	EXAMINER	
PERKINS COIE LLP PATENT-SEA P.O. BOX 1247 SEATTLE, WA 98111-1247			JASMIN, LYNDIA C	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 10/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	Application No. 09/718,445	Applicant(s) ADAMS ET AL.	
	Examiner Lynda Jasmin	Art Unit 3627	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 September 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

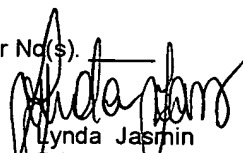
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: _____.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s): _____.
 13. ☐ Other: _____.


 Lynda Jasmin
 Primary Examiner
 Art Unit: 3627

Continuation of 11. does NOT place the application in condition for allowance because:

Applicants proposed amendment to the specification filed March 03, 2005 has been entered. However, for claims 25-43 and 67 as currently stated, priority to the provisional Application U.S. 60/166,664 ("Provisional Application") and to Serial No. 09/715,850 is hereby denied. Therefore claims 25-43 and 67 are only entitled to the filing date of November 20, 2000.

Any claim in a continuation-in-part application ("CIP") which is directed solely to subject matter adequately disclosed under 35 U.S.C. §112 in the parent application is entitled to the benefit of the filing date of the parent application. However, if a claim in a continuation-in-part application recites a feature which was not disclosed or adequately supported by a proper disclosure under 35 U.S.C. §112 in the parent application, but which was first introduced or adequately supported in the continuation-in-part application such a claim is entitled only to the filing date of the continuation-in-part application. See *Applied Materials v. Advanced Semiconductor Materials, Inc.*, 98 F.3d 1563, 40 USPQ2d 1481, 1496 (Fed. Cir. 1996). In other words, the priority date in a CIP to any parent application is based upon a claim-by-claim analysis. Thus it is entirely possible for different claims in a CIP to have different effective U.S. filing dates.

In particular, the US Application and the Provisional Application do not support the "detecting that the second customer has purchased an item for a person other than the first" as recited in claim 25 because according to Applicants comparison "[w]ith each new purchase, the customer is asked whether the customer wants to designate the purchase as private or hidden" (Parent, p. 24)

"Users will get notified on the web site when a new event has occurred in his or her Personal Purchase Circle... [w]hen a member of the customer's Personal Purchase Circle bought something." (Provisional, p.3). Nowhere do they show that the purchase is for a person other than the first. Further, in claim 25 the recitation "determining that the first customer has a purchase notification relationship with the second customer" is not supported via "[i]f the customer designates the purchase as public, then the purchase and related information will be automatically shared with a customer's Personal Purchase Circle" (Parent, p. 24) and "Customers can view their Personal Purchase Circle, and have the ability to remove or add people." (Provisional, p.4) as illustrated by Applicants.

Thus, it is the Examiner's factual determination that claim 25 is not supported by a proper disclosure under 35 U.S.C. 112 1st paragraph. "The purpose of the written description requirement is to prevent an applicant from later asserting that he invented that which he did not; the applicant for a patent is therefore required to recount his invention in such detail that his future claims can be determined to be encompassed within his original creation." *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 65 USPQ2d 1385, 1397 (Fed. Cir. 2003) (citations and quotations omitted). Moreover, "[t]he issue of whether a patent specification adequately describes the subject matter claimed is a question of fact." *In re Alton*, 76 F.3d 1168, 1171-72, 37 USPQ2d 1578, 1580 (Fed. Cir. 1996) (citations omitted). However, "the invention claimed does not have to be described in *ipsis verbis* in order to satisfy the description requirement of § 112." *In re Lukach*, 442 F.2d 967, 169 USPQ 795, 796 (CCPA 1971).

While the features of claim 25 may be obvious in view of Applicant's disclosure, this nevertheless does not satisfy the written description requirement. "Entitlement to a filing date does not extend to subject matter which is not disclosed, but would be obvious over what is expressly disclosed. It extends only to that which is disclosed." *In re Huston*, 308 F.3d 1267, 1277, 64 USPQ2d 1801, 1807 (Fed. Cir. 2002) citing *Lockwood v. Am. Airlines Inc.*, 107 F.3d 1565, 1571-72, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997)..